

REMARKS

Regarding the objection to the Oath, enclosed herein is another copy of the filed Oath which references the specification, which omission was an inadvertent typographical error. Further, enclosed are corrected drawings which label Figures 15-17 as "Prior Art." Regarding the alleged omission of reference numeral 12 in the specification, the Examiner is directed to page 10, line 13 thereof which mentions reference numeral 12. Accordingly, it is respectfully requested that the objection to the drawings and Oath be withdrawn.

Claim 1 is the sole independent claim and stands rejected under 35 U.S.C. § 103 as being unpatentable over Sato in view of Okumura. This rejection is respectfully traversed for the following reasons.

Claim 1 recites in pertinent part, a "battery pack being movable from an initial position to a fixing position *while said external terminal has been inserted in said inserting part*, and connection between said external terminal and said discharge terminal being achieved at said fixing position" (emphasis added). The Examiner relies on Sato as allegedly disclosing this feature (Okumura is relied-on solely for allegedly disclosing a charge circuit, so that Okumura does not obviate the below-discussed deficiencies of Sato).

It is respectfully submitted that the battery of Sato is NOT movable once the alleged external terminal 14 has already been inserted in the alleged inserting part. As shown in Figures 4A-4B of Sato, the connection between the external terminal 14 and the alleged discharge terminal 16 is effected by a single motion. That is, the connection is made when the external terminal 14 is *inserted* in the inserting part. In contrast, as recited in claim 1, the claimed battery pack is configured to be "movable from an initial position to a fixing position while said external

terminal *has been inserted* in said inserting part” so as to embody two motions; namely, insertion of the external terminal in the inserting part and the movement from the initial position (i.e., when external terminal is already insertedd in the inserting part) to the fixing position.

Indeed, one of the objects of the present invention is to prevent charging from the discharge terminal when a lead wire or the like connected to a large-sized battery or the like is inserted in the inserting part, by averting the lead wire from being connected to the discharge terminal (*see* page 5, lines 14-19 of Applicants’ specification). In this regard, the Examiner’s attention is directed to page 5, lines 6-19 of Applicants’ specification, which describes the two-motion configuration of the present invention as recited in claim 1.

‘the discharge terminal is disposed in a concealed position’ means that the discharge terminal of the discharge circuit and the external terminal are not mutually connected *in the initial position immediately after the insertion of the external terminal of the mounting part into the inserting part*. The connection between the external terminal and the discharge terminal requires [a second motion, for example,] rotation of the battery pack from the initial portion or sliding thereof in a direction different from the inserting direction. (emphasis added).

Whereas, according to the one motion configuration of Sato, the discharge terminal of Sato is accessible to a charging lead so as to be subject to the drawbacks described in Applicants’ specification. In this regard, Sato is merely cumulative to Applicants’ admitted prior art described on pages 1-3 of Applicants’ specification.

In view of the foregoing, it is respectfully submitted that neither Sato nor Okumura, alone or in combination, disclose or suggest the combination of features recited in claim 1. The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejections do not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 1 because the proposed combinations fail the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

For example, new claims 9 and 10 recite a "battery pack being *rotatable* from the initial position to the fixing position" and a "battery pack being slidable from the initial position to the fixing position *in a direction different from the inserting direction*" (emphasis added), respectively. Support for claims 9-10 can be found, for example, on page 5, lines 11-14 of Applicants' specification. In contrast, the insertion of Sato is not rotational and is in only one direction. Indeed, as discussed above, Sato is not movable once inserted in the inserting part (i.e., initial position).

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Ramyar M. Farid
Registration No. 46,692

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 RMF:MaM
Facsimile: 202.756.8087
Date: April 3, 2006

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as our correspondence address.**